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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/821,158	04/08/2004	David B. Sutton	PRIV 0107 PUS	9192
22045	7590	03/10/2008		
BROOKS KUSHMAN P.C. 1000 TOWN CENTER TWENTY-SECOND FLOOR SOUTHFIELD, MI 48075			EXAMINER PATEL, JAGDISH	
			ART UNIT 3693	PAPER NUMBER
			MAIL DATE 03/10/2008	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/821,158	Applicant(s) SUTTON ET AL.	
	Examiner JAGDISH PATEL	Art Unit 3693	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 April 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 15-27 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 15-27 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____. |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>4/8/04, 7/29/04, 10/25/05, 6/20/06, 6/28/06, 6/7/06</u> . | 6) <input type="checkbox"/> Other: _____. |

DETAILED ACTION

Information Disclosure Statement

1. Certain Non-patent references listed on the IDS form PTO-1449 have not been considered since these references have been listed in the parent application 09/363499 as indicated in the IDS statement submitted 4/8/2004.

Status of the Application

2. Claims 15-27 are currently pending and have been examined. (Refer to Preliminary amendment filed 4/8/04).

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 18 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Independent claim 15 states that the purchase card does not identify the person who acquired the purchase card. Whereas, claim 18 contradicts with this feature, stating that a plurality of cards embodies a different account number but having the same card holder name. The claim is therefore is vague and unclear.
5. Additionally, none of the features of claim 18 have any correlation to the process recited in claim 15.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. Claim 15-17, 19, 22 and 25 are rejected under 35 U.S.C. 102(e) as being anticipated by Risafi et al (US Pat. 6473500) (hereafter Risafi).

8. As per claim 15 Risafi teaches a method of transacting a purchase which comprises acquiring a purchase card from a provider (see col. 3 L 53-60). Such card is a bearer instrument having an account number (Fig. 3a 306), but does not identify the person who acquired the card.

Risafi further teaches transacting a purchase with a retailer based on the account number associated the purchase card after purchase transactional information including the account number is provided to a retailer who is not the card provider (see Fig. 6a and relevant description of purchase at a merchant).

As per claims 16 and 17 the purchase card has indicia of a card issuer (310 and 304). However, the purchase card does not have an indicia of an interchange association and indicia of other entity associated with distribution of the card. However, this data on the purchase card does not contribute the functionality of the claimed process and hence treated as non-functional descriptive material. Accordingly, no patentable weight is given to these non-functional descriptive. It has been ruled by the courts that non-functional descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see *In re Gulack*,

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703 F.2d 1381, 1385, 217 USPQ 401,404 (Fed. Cir. 1983), In re Ngai 367 F.3d 1336, 1339, 70 USPQ2d 1862, 1864 (Fed. Cir. 2004)

The examiner also respectfully submits that this analysis is consistent with the USPTO policy as affirmed by the Board of Patent Appeals and Interferences (BPAI) (See Ex Parte Herman Mathias, Appeal No. 2005-1851 available at link <http://www.uspto.gov/web/offices/dcom/bpai/its/fd051851.pdf>)

which states that a process that differs from the prior art only with respect to nonfunctional descriptive material that cannot alter how the process steps are to be performed to achieve the utility of the invention cannot not lend patentability to an invention that would have been anticipated by prior art.

As per claim 19 Risafi teaches a step of acquiring a purchase card further comprises purchasing the purchase card from a retail establishment, where the purchase card is provided to the retail establishment by the purchase card provider. (col. 3 L 55 - col. 4 L 16).

As per claim 22, Risafi teaches a step activating the purchase card (see col. 3 L 61-65).

As per claim 25 Risafi teaches a step of transacting a purchase with the retailer by way of an authorization system of an interchange association (any authorization of card is carried out over a payment network. such step is therefore, inherent in Risafi, see Fig. 6a)

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.

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2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

11. Claims 20, 21, 23 and 24 and 26-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Risafi as applied to claim 19 above, and further in view of Official Notice.

Various feature recited in claims 20-23 such as consignment arrangement and service fee charges are old and well known practices in commerce and the examiner takes official notice of these facts.

It would have been obvious to one of ordinary skill in the art at the time of the invention to implement these features in order to provide incentives to the card distributors so as to participate in the card distribution process. Providing contact information is also old and well known feature and is provided to facilitate communication with the card issuer regarding account balances etc.

. All limitations of claims 26 and 27 have been fully analyzed in the foregoing analysis.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JAGDISH PATEL whose telephone number is (571) 272-6748.

The examiner can normally be reached on 800AM-630PM Mon-Tue and Thu.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **KRAMER JAMES A** can be reached on **(571)272-6783**. The fax phone number for the organization where this application or proceeding is assigned is **571-273-8300**.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/JAGDISH PATEL/

Primary Examiner, Art Unit 3693

February 19, 2008